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11-9

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,386	06/03/2005	Michael Ried	08146.0008UI	4544

23859 7590 04/13/2007
NEEDLE & ROSENBERG, P.C.
SUITE 1000
999 PEACHTREE STREET
ATLANTA, GA 30309-3915

EXAMINER

KIM, AHSHIK

ART UNIT	PAPER NUMBER
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2876

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/537,386

Applicant(s)

RIED ET AL.

Examiner

Ahshik Kim

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/3/05 (Preliminary Amendment).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 June 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 06/05, 03/06.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers
5 have been placed of record in the file.

Preliminary Amendment

2. Receipt is acknowledged of the preliminary amendment filed on June 3, 2005. Currently,
claims 1-8 remain in the examination.

10

Drawings

3. This application is filed with informal drawings which are acceptable for examination
purposes only. Formal drawings will be required in response to this Office Action or when the
application is allowed.

15

4. Figures 1 and 2 should be designated by a legend such as --Prior Art-- because only that
which is old is illustrated. See MPEP § 608.02(g). See drawings of Kobayashi et al. (US
2002/0053598). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply
to the Office action to avoid abandonment of the application. The replacement sheet(s) should be
labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any
20 portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will
be notified and informed of any required corrective action in the next Office action. The
objection to the drawings will not be held in abeyance.

Specification

5. Applicant(s) are reminded to include the following in the next communication with respect to the header(s) within the specification as following:

a) **-- Background of the Invention --**: The specification should set forth

5 Background of the Invention in two parts: **--Field of the Invention --** and **-- Description of the Related Art --**. (if there are prior arts cited by the Applicant).

b) **-- Brief Summary of the Invention --**.

c) **-- Brief Description of the Several Views of the Drawing(s) --**.

d) **-- Detailed Description of the Invention --**.

10 See MPEP 608.01. Appropriate correction is required.

Claim Objections

6. Claim 1-8 are objected to because of the following informalities:

15 Re claim 1, line 1: substitute "Smart card" with --A smart card--.

Re claims 2-6, line 1: substitute "Smart card" with --The smart card--.

Re claim 7, line 1: substitute "Method" with --A method--.

Re claim 8, line 1: substitute "Method" with --The method--.

Appropriate correction is required.

20

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Ghaem et al. (US
5 6,161,761, hereinafter "Ghaem").

Re claims 1, and 7 Ghaem discloses an smart card (see figures 1 and 2) and the method
for manufacturing the smart card (col. 1, lines 7+) wherein the smart card comprises a card body
16 and 22 which further comprises a recess in which the IC chip 38 is mounted, the IC chip
having a connecting means 42 in the edge region of the IC module; a conductive structure body
10 embedded in the card – embodied as antenna 24, 26, and 28 – and having body contact
connections 34; the antenna is below the edge region; and the chip module appears to be between
the connecting means 42 and the antenna 24, 26, 28, and 34, which is filled with conductive
paste 44 which is elastic and conductive (col. 6, lines 20-46).

Re claims 2 and 3, the space occupied by the adhesive parts – conductive paste can be
15 considered a cutout (see figure 2). In manufacturing step, a pressure or heat is applied to the
card (col. 3, lines 48+; col. 4, lines 17+).

Re claim 4, it is the Examiner's view that if pressure is not applied, the adhesive may
occupy larger/higher space than the height of 44.

Re claim 5, the conductive medium 44 is cured (col. 6, lines 54+).

20 Re claim 6, all card parts including the main body 16 and 22, and conductive medium 44,
to certain extent serves as a buffer in that they maintain the physical structure and integrity of the
card.

Allowable Subject Matter

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9. Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The following is a statement of reasons for the indication of allowable subject matter: the

5 claims are directed at a method for producing smart card. The method recited in claim 8 is neither disclosed nor suggested by the cited references.

Conclusion

10 I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Leighton (US 6,514,367); Brechignac et al. (US 6,174,113); Zafrany et al. (US 6,677,186); Tarantino et al. (US 6,467,692); Kobayashi et al. (US 2002/0053598) disclose smart card and methods for manufacturing smart cards. Applicant is respectfully suggested to carefully review these references.

15 II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (571)272-2393. The examiner can normally be reached between the hours of 8:00 AM to 5:00 PM Monday thru Friday.

20 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571)272-2398. The fax phone number for this Group is (571)273-8300.

25 Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

30 *All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

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5 Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished application is available for Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions or access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ahshik Kim
Primary Examiner
Art Unit 2876
April 10, 2007